UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

BAC

Mailed: August 21, 2002

Opposition No. 120,415

Caracolillo Coffee Mills, Inc.

v.

Pan American Coffee Co., Inc.

Before Hohein, Chapman, and Holtzman, Administrative Trademark Judges.

By the Board:

Pan American Coffee Co., Inc. (a New Jersey corporation) has filed an application to register on the Principal Register the mark CAFE CARACOLILLO for "coffee," based on applicant's claimed date of first use and first use in commerce of 1951.[1]

Caracolillo Coffee Mills, Inc. (a Florida corporation) has opposed registration of applicant's mark, alleging that opposer is the owner of the mark CAFE CARACOLILLO for coffee; that opposer has used the mark continuously in

[1] Application Serial No. 75/691,467, filed April 27, 1999. Applicant disclaimed the word "cafe"; and included a statement that "the English translation of "CARACOLILLO" is "snail shell."

connection with coffee since long prior to applicant's claimed date of first use; that opposer owns application Serial No. 75/667,025[2] which has been refused registration in view of the prior pending application of applicant (Serial No. 75/691,467); and that applicant's mark, when used on its goods, so resembles opposer's mark as to be likely to cause confusion, mistake, or deception.

In its answer, applicant admits that it has not used the involved mark for coffee anywhere or in commerce prior to 1951, but applicant otherwise denies the allegations of the notice of opposition.

This case now comes up on opposer's motion for summary judgment (filed November 21, 2001) on the ground of priority and likelihood of confusion. Opposer contends that it has priority of use; and that there is a likelihood of confusion because the marks, the goods, and the channels of trade are identical.

In support of its motion for summary judgment, opposer submitted the declarations of Julian Faedo, opposer's vice president; and Eusebio Faedo, opposer's former president. Eusebio Faedo avers that opposer was founded in 1936 by his

[2] Opposer's application Serial No. 75/667,025 was not granted its original filing date, but was given a corrected filing date of July 20, 1999, which is subsequent to applicant's filing date of April 27, 1999. The word "cafe" has been disclaimed; and the application includes a statement that "the English translation of "CARACOLILLO" is "snail shell." Action on opposer's application is suspended in Law Office 101.

father-in-law, Anastasio Fernandez; that in 1936 Mr. Fernandez obtained an occupancy license from the state of Florida to undertake a business for the roasting and sale of coffee at a location in Tampa, Florida; that the business in fact commenced in 1936; that Eusebio Faedo began working at Caracolillo Coffee Mills, Inc. in 1950; that Mr. Fernandez turned over control to Eusebio Faedo in 1955, who served as president from 1955 to 1986; that opposer has continuously used the mark CAFE CARACOLILLO for coffee since 1936, and in interstate commerce from 1950 to the present; and that the declarant's personal knowledge of this continuous use of this mark dates to 1940.

Mr. Julian Faedo avers that he began working for opposer in 1969; that he is opposer's vice president and has held that office since 1986; that opposer filed application Serial No. 75/667,025 on July 20, 1999 to register the mark CAFE CARACOLILLO for coffee; that opposer has continuously used the mark CAFE CARACOLILLO for coffee since 1936, and in interstate commerce from 1950 to the present; that the declarant's personal knowledge of this continuous use of this mark dates to 1969; that opposer's coffee is offered and sold nationwide through various channels of trade, including to distributors, to retail and grocery stores, through the Internet, and directly to consumers via telephone.

The Board suspended proceedings herein pursuant to Trademark Rule 2.127(d) on December 21, 2001.

Confronted with opposer's motion for summary judgment, applicant on the last day of its time to respond thereto, (December 26, 2001 -- via a certificate of mailing), filed a motion to suspend this proceeding "to allow Applicant to file a motion to amend the subject application to one for concurrent use, excepting Opposer to Applicant's claim of use"; and alternatively, to extend applicant's time to respond to the motion for summary judgment.

On May 6, 2002 the Board denied applicant's motion to suspend, but granted applicant's alternative motion to extend its time to respond to opposer's motion for summary judgment.[3]

In its response to opposer's motion for summary judgment, applicant argues that there is a genuine issue of material fact as to ownership of the mark CAFE CARACOLILLO; that the only declaration based on personal knowledge

[3] Although not clearly articulated in the interlocutory order, the motion to suspend was denied because there was no showing of good cause to suspend set forth in applicant's motion. Specifically, applicant simply requested time to file a motion to amend its application to one for concurrent use. However, there is no indication why that was not done previously or was not filed simultaneously with the motion to suspend. This opposition was commenced in June 2000, and applicant has never previously raised this issue. See Trademark Rule 2.117(c). The applicant's alternative motion to extend its time to respond to opposer's summary judgment motion was granted because good cause was shown in view of the potentially dispositive nature of a motion for summary judgment and applicant had moved to suspend in a timely manner.

predating applicant's claimed use date is that of Eusebio Faedo, which is a self-serving statement of opposer's past president, and without documentary evidence of prior use; that applicant should have the right to cross-examine this witness during either a discovery deposition or during the testimony period, especially because "Opposer's claimed date of first use is only a year before Applicant's date of first use" (responsive brief, p. 1); that opposer has acknowledged that there have been no instances of actual confusion "despite the fact that both parties have been allegedly using the CAFE CARACOLILLO mark for over fifty years, each in their own respective geographic area" (responsive brief, p. 2); and that the proper procedure to resolve this case is a concurrent use proceeding.

In its reply brief, opposer argues that its two declarations comply with the requirements of Fed. R. Civ. P. 56; that applicant submitted no specific evidence disputing the contents of the declarations; that the two declarations establish opposer's first use and first use in commerce dates of 1936 and 1950 respectively, while applicant has submitted no evidence and thus is left to the filing date of applicant's application (April 27, 1999); that opposer produced to applicant invoices dated prior to applicant's filing date (and which were attached to opposer's reply brief); that applicant had ample opportunity to take

discovery depositions in this case, but failed to do so; that there is sufficient evidence to establish opposer's right to judgment as a matter of law; that the absence of evidence of actual confusion is not sufficient to raise a genuine issue of material fact because applicant has failed to submit any evidence of any use of the mark CAFE CARACOLILLO by applicant, and because even if there were evidence of such use by applicant, the fact that one party is not aware of any instances of actual confusion generally carries little weight; and that when viewed in the light most favorable to applicant, applicant has failed to raise any genuine issue of material fact.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material fact. See Celotex Corp. v. Catrett, 477 U.S. 317 (1986); and Sweats Fashions Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine, if, on the evidence of record, a reasonable finder of fact could resolve the matter in favor of the non-moving party. See Opryland USA Inc. v. Great American Music Show Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and Olde Tyme

Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See Lloyd's Food Products Inc. v. Eli's Inc., 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); and Opryland USA, supra.

The party responding to a properly supported summary judgment motion may not rest on mere denials or conclusory assertions or technical challenges without challenging the motion on the merits, but rather, must proffer countering evidence, by affidavit (or declaration) or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial. See Copelands' Enterprises Inc. v. CNV Inc., 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); and Octocom Systems Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). See also, Spin Physics, Inc. v. Matsushita Electrical Industrial Co., Ltd., 168 USPQ 605 (TTAB 1970).

Based on the record before us, we find that there is no genuine issue of material fact, and that opposer is entitled to judgment as a matter of law.

There is no genuine issue of material fact as to opposer's standing in view of the declarations of Eusebio Faedo and Julian Faedo that opposer has earlier use of the

same mark for the same goods as applicant (CAFE CARACOLILLO for coffee).

Turning to the issue of priority, we find that there is no genuine issue of material fact, and that opposer has established its priority. Applicant challenges the sufficiency of opposer's declarations of a current and a past officer as self-serving and that these witnesses should be subject to cross-examination by applicant. However, the only citation to authority on this question is applicant's citation to Poller v. Columbia Broadcasting System, Inc., 368 U.S. 464, 473 (1962). This is a Supreme Court case involving a television network allegedly violating antitrust laws in acquiring a competing television station and cancelling the affiliation in accordance with the affiliation agreement. The Supreme Court reversed a granting of summary judgment, stating that summary judgment should be used sparingly in complex antitrust litigation where motive and intent play leading roles; and in that context the Court commented that it is only when witnesses are present and subject to cross-examination that their credibility and the weight to be accorded their testimony can be appraised.

While we do not disagree with the general principle regarding witnesses set forth in the Supreme Court case cited by applicant, the situation before the Supreme Court

must be compared to that now before this Board (an opposition proceeding concerning only the issue of the registrability of a trademark), and our cases holding that affidavits (or declarations) which comply with the requirements of Fed. R. Civ. P. 56(e) are acceptable. In particular, even if not supported by documentary evidence, an affidavit (or declaration) may nevertheless be given consideration if the statements contained therein are clear and uncontradicted. See, e.g., C & G Corp. v. Baron Homes, Inc., 183 USPQ 60 (TTAB 1974); and 4U Co. of America, Inc. v. Naas Foods, Inc., 175 USPQ 251 (TTAB 1972).

The declarations submitted by opposer comply with Fed. R. Civ. P. 56(e); and even though they are the declarations of interested witnesses, there is nothing in the record to indicate that the declarations contain any untruths or were colored in favor of their employer. That is, we have no reason to believe the declarants failed to tell the truth. See Harco Laboratories, Inc. v. The Decca Navigator Company Limited, 150 USPQ 813, 815 (TTAB 1966). Even applicant does not so contend; rather, applicant argues it should have the right to cross-examine the witnesses. Of course, applicant did have that right and failed to avail itself of the opportunity. Discovery opened in this case on December 5, 2000 and was set to close on June 3, 2001, but by extension closed on October 1, 2001. When applicant served a revised

Fed. R. Civ. P. 30(b)(6) notice on opposer on September 26, 2001 for a deposition to be held October 1, 2001 (the date then set for discovery to close), the parties' attorneys conferred and agreed to make the Rule 30(b)(6) witness available after the close of discovery and after applicant received opposer's answers to applicant's discovery requests. Opposer served its answers to such discovery requests on applicant on October 22, 2001, but applicant made no further attempt to obtain a discovery deposition. Also, upon receipt of opposer's motion for summary judgment, applicant had thirty days (and only thirty days) under Trademark Rule 2.127(e)(1) in which to request Fed. R. Civ. P. 56(f) discovery; and again applicant did not do so. Applicant's argument that it needs to cross-examine opposer's witnesses rings hollow.

Applicant submitted no evidence regarding applicant's use of the mark (for example, the affidavit or declaration of an officer of applicant corporation, with or without accompanying documentation). Therefore, applicant is only entitled to rely on the filing date of its application--April 27, 1999. See Chicago Corp. v. North American Chicago Corp., 20 USPQ2d 1715, 1716 (TTAB 1991). Opposer has clearly established use prior to April 27, 1999 as the

declarations establish opposer's use of the mark CAFE CARACOLILLO for coffee since 1936.[4]

Applicant's argument that "this case apparently presents a very close question regarding priority" (applicant's responsive brief, p. 5) is inaccurate. Applicant has not raised any genuine issue of material fact regarding priority. Even applicant's assertion that there should be a concurrent use proceeding does not raise a genuine issue of material fact as geographic restrictions cannot be determined in opposition proceedings. See Trademark Rule 2.133(c).

Turning to the issue of likelihood of confusion, the parties' marks are identical; the goods are identical; and inasmuch as there is no restriction in either party's identification of goods, the normal trade channels and classes of purchasers, are identical as well. Based thereon, we find that there is no genuine issue of material fact as to likelihood of confusion, and that opposer is entitled to summary judgment thereon.

Applicant's contention that opposer's statement (in response to an interrogatory) that it knows of no instances of actual confusion despite the many years of use by both

[4] Applicant's statement that "Opposer's claimed date of first use is only a year before Applicant's date of first use" (applicant's responsive brief, p. 1) is factually incorrect because opposer's claimed date of first use is 1936, or 15 years prior to applicant's claimed first use date.

parties raises a genuine issue of material fact on likelihood of confusion is simply unpersuasive. In this opposition proceeding, applicant submitted no evidence of applicant's use, much less the specifics of the nature and geographic extent of any such use. In fact, applicant has implied since December 26, 2001 that the parties sell their goods in different geographic areas of the United States. This could account for the lack of reported instances of actual confusion. Therefore, the factor of actual confusion does not serve to raise a *genuine* issue of *material* fact in this case. See Trek Bicycle Corp. v. Fier, 56 USPQ2d 1527, 1529 (TTAB 2000).

In sum, applicant has failed to disclose any evidence that points to the existence of a genuine issue of material fact on any issue involved herein. In view thereof, opposer's motion for summary judgment is granted.

Accordingly, the opposition is sustained and registration to applicant is refused.